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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,735	01/09/2002	David D. Roberts	15280-3971US	8279

7590

07/12/2005

Kenneth A Weber  
Townsend & Townsend & Crew  
8th Floor  
Two Embarcadero Center  
San Francisco, CA 94111-3834

EXAMINER

HADDAD, MAHER M

ART UNIT

PAPER NUMBER

1644

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/030,735

Applicant(s)

ROBERTS ET AL.

Examiner

Maher M. Haddad

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-10, 13, 14, 20, 21, 23-26, 28-30 and 46-54 is/are pending in the application.
- 4a) Of the above claim(s) 20, 21, 23-26 and 28-30 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 10, 53 and 54 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 7-9, 13, 14 and 46-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1644

## RESPONSE TO APPLICANT'S AMENDMENT

1. In view of Applicant's concern regarding the finality of the previous office action, the previous Office Action mailed March 24, 2005 is considered a non-Final. Since the response to said Office Action has been entered, the instant Office Action is made Final.
2. Applicant's amendment, filed 6/24/05, is acknowledged.
3. Claims 1-5, 7-10, 13-14, 20-21, 23-26, 28-30 and 46-54 are pending.
4. Claims 20-21, 23-26, 28-30 stand withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b) as being drawn to a nonelected invention.
5. Claims 1-5, 7-10, 13-14 and 46-54 are under consideration in the instant application.
6. The status identifier of the claims should be properly corrected. Claims 20-21, 23-26, 28-30 have a status identifier that does not reflect that said claims are withdrawn. For example claims 20, 26 and 29-30 indicate that the status of the claims is (Currently amended), the status of said claims should be changed to (Withdrawn-currently amended). Further claims 21, 23-25 and 28 indicate that the status of the claims is (Original), the status of said claims should be changed to (Withdrawn). Correction is required.
7. In view of the amendment filed on 6/24/05, only the following rejections are remained.
8. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*
9. Claims 1-3, 5, 7, 13-14 and 46-52 stand rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a peptide consisting of SEQ ID NOs: 19, 22 and 24-32 or their full retro-inverso peptide sequence, does not reasonably provide enablement for any peptide consisting of the sequence R1-X1-V-R-X4-R2 or "partial" or full retro-inverso sequences in claim 1, that contains "at least one D-amino acid" in claim 7; or a peptide consisting of the sequence R1-D-V-R-F-R2, or "partial" or full retro inverso sequences thereof in claims 46, that contains "at least one D-amino acid" in claim 50. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and or use the invention commensurate in scope with this claim for the same reasons set forth in the previous Office Actions mailed 5/21/04 and 3/24/05.

Applicant's arguments, filed 6/24/05, have been fully considered, but have not been found convincing.

Art Unit: 1644

Applicant submits that no issue of non-enablement exists in light of the claim revisions.

However, it has clearly stated in the previous office action mailed 5/21/04 that “at issue is the partial retro-inverso peptide sequence which comprises at least one-D-amino acid. The specification on page 34, discloses peptide709, which is all D amino acid. No partial retro-inverso peptide sequences has been disclosed, not at least one D-amino acid. Therefore, one skilled in the art at the time of the invention would not be able to predict which amino acid of the peptide can be D-amino acid and still provide inhibition of  $\alpha 3\beta 1$ /TSP1 interaction. Consequently the skilled artisan would not know how to make the instant invention as broadly claimed.” Applicant has not address the issue of partial retro-inverso neither the issue of “at least one D-amino acid”. The rejection is maintained for the reasons of record.

10. Claims 1-3, 5, 7, 13-14 and 46-52 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the same reasons set forth in the previous Office Actions mailed 5/21/04 and 3/24/05.

Applicant's arguments, filed 6/24/05, have been fully considered, but have not been found convincing.

Applicant has not address the issues of partial retro inverso sequences neither the at least one D-amino acids. The rejection is maintained for the reasons of record.

11. The following new ground of rejections are necessitated by the amendment submitted 6/24/05.

12. The amendment filed 6/24/05, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The amendment filed on 6/24/05 to the paragraph at page 16, lines 22-32 substituting generic formula with specific species represents a departure from the specification and the claims as originally filed. Applicant submits that the amendment was made to emphasize the disclosure by reciting each sequence encompassed by sequence R1-X1-X2-X3-X4-R2 (I). However, the specification and the claims as originally filed have no support for the new replacement of such sequences.

Applicant is required to cancel the new matter in the reply to this Office action.

13. It is noted that newly submitted SEQ ID NOs: 57-145 do not comply with the sequence rules.

Art Unit: 1644

14. Claims 1-3, 7-9 and 13-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a New Matter rejection.

The phrase "N-V-R-L (SEQ ID NO: 57), O-V-R-L (SEQ ID NO:80), and D-V-R-L (SEQ ID NO: 102)" claimed in claims 1 and 8 represents a departure from the specification and the claims as originally filed.

Applicant's amendment filed 6/24/05 points to the specification at newly amended page 16 for support for the newly added limitations "N-V-R-L (SEQ ID NO: 57, O-V-R-L (SEQ ID NO:80), and D-V-R-L (SEQ ID NO: 102)" as claimed in claims 1 and 8. However, the specification does not provide a clear support of such sequences. Applicant contends that those sequences are within the scope as of the formula previously presented. However, such sequences were not present in the specification and claims as originally filed. The instant claims now recite a limitation which was not clearly disclosed in the specification and recited in the claims as originally filed.

15. Claims 4, 10 and 53-54 are allowable.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maher Haddad whose telephone number is (571) 272-0845. The examiner can normally be reached Monday through Friday from 7:30 am to 4:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (571) 272-0841. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

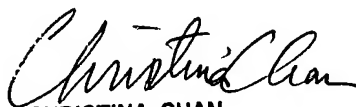
Art Unit: 1644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maher Haddad, Ph.D.

Patent Examiner

July 8, 2005



CHRISTINA CHAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600